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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,649	12/28/1999	AMY MULDERRY	07019.0004	1261
22852	7590	07/28/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			O CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,649

Applicant(s)

Mulderry et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 26, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 28, 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on April 26, 2004 (Paper N^o 20040426) in reply to the Office action mailed December 24, 2003.
2. The amendment of claims 1, 2, 4, 5, and 7 by applicant in Paper N^o 20040426 is hereby acknowledged.
3. The cancellation of claims 3 and 6 by applicant in Paper N^o 20040426 is hereby acknowledged.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 5,926,796), in view of Watanabe et al. (US 5,543,607).

Walker et al. disclose a method of completing a plurality of transactions on a computer network involving at least one customer computer and a plurality of merchant computers, said method comprising the following steps:

transmitting an offer (to buy a single issue of a magazine for a particular price) from a first merchant computer 122 to a customer 110 computer 120 (the computer provided to interface with the customer 110 and process the customer's 110 transactions);

transmitting customer-inputted information (name and method of payment) from the customer computer 120 to the first merchant computer 122 in response to the offer;

utilizing the customer-inputted information to process 1335 the offer, wherein said customer-inputted information contains a payment method (method of payment) and customer identification data (customer name) required by said first merchant to process said offer;

transmitting 1325 to said customer computer 120 a second offer from a second merchant computer 130 (an offer to buy a subscription to the magazine, it being considered inherent that the subscription offers are provided from the magazine publishers to the retailer to sell); and,

transmitting said customer-inputted information from said first merchant computer 122 to said second merchant computer 130, provided said customer computer 120 accepts said second offer;

processing said customer-inputted information by said second merchant computer 130;

causing merchandise to be delivered 1550 to a customer associated with said customer-inputted information (see, in particular, Figs. 14 and 15); and,

automatically debiting a customer account (it being inherent that the publisher maintains an account for each customer containing the number of remaining issues owed to the customer) corresponding to said customer-inputted information after said merchandise has been delivered (debiting the account of issues-owed by one issue after each additional issue is delivered), provided said customer does not cancel future delivery of said merchandise (see, in particular, column 12, lines 6-53),

but, the customer computer of Walker is operated by a store clerk rather than directly operated by the customer, the customer information being inputted by the customer to the store clerk who then actually keys in the data into the customer computer.

However, Watanabe et al. show a similar customer computer to the customer computer of Walker et al., except that the customer computer of Watanabe et al. is indeed operated directly by the customer, rather than by the store clerk.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Walker et al. so as to have the customer computer operated directly by the customer rather than operated by a store clerk, in accordance with the teachings of Watanabe et al., in order to improve efficiency by employing fewer store clerks, thereby reducing operating costs and increasing profits.

Regarding claims 2, 4, 8, and 9, Walker et al. disclose that the step of transmitting an offer is further comprised of the following steps:

sending 370 an offer from said second merchant computer 130 to said first merchant computer 122;

storing 342 said offer on said first merchant computer 122 (see, in particular, Fig. 3); and, presenting said offer 1325 by said first merchant computer 122 to said customer computer 120 (see, in particular, Fig. 13).

Regarding claim 5, the merchandise of the method of Walker et al. is a predetermined number of issues of a periodical.

Response to Arguments

6. Applicant's arguments filed April 26, 2004 have been fully considered but they are not persuasive.

7. Regarding the argument that Walker et al. fail to expressly disclose the "step of automatically debiting a customer account for a purchase ... after the merchandise has been delivered," express disclosure of features that are necessarily, thus inherently, present is not required, for it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to the disclosure.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC



July 22, 2004

 7/24/04

ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600